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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,748	10/24/2003	Dennis W. Waggamon	125426-1089	2451
7590 01/16/2007 KENNETH R. GLASER MICHAEL E. MARTIN GARDERE WYNNE SEWELL LLP 1601 ELM STREET, SUITE 3000 DALLAS, TX 75201			EXAMINER HOLLOWAY III, EDWIN C	
			ART UNIT 2612	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/693,748

Applicant(s)

WAGGAMON ET AL.

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10-24-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08) ✓
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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EXAMINER'S RESPONSE

1. In response to the application filed 10-24-03, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Specification

2. The disclosure is objected to because of the following informalities: The continuing data should be updated to include the patent numbers of the parent applications.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or

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provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-2 and 5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6049289. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1-2 generally broader than the claims in the patent. Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork"). Regarding claim 1, The mechanism operable connected to a garage door is in claim 4 of the patent. The plurality of transmitters in claim 1(a), the receiver in claim 1(a,b), first means in claim 1(c) and second means in claim 1(e) of the patent. Instant claim 1 is broader than the

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patent in not requiring the learn mode and operate mode.

Regarding claim 2, the first synch value incremented is in claim 1(a) of the patent.

Regarding claim 5, random storage is included in claim 1(d) of the patent.

5. Claims 3 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 of U.S. Patent No. 6049289 in view of Bruwer'187 (US005517187A) or Brewer'904 (US 5686904).

Claims 1 and 4 of US6049289 include the limitations of claim 5 for the same reasons applied above to claim 1 except that US6049289 does not claim multibit secret keys at the transmitters and corresponding, but separate multibit secret keys at the receiver.

Bruwer'187 discloses an analogous art access system with hopping codes having sync values, nonlinear decoding and receiver with separate multibit secret key 14 in fig. 2. See cols. 3-6.

Bruwer'904 discloses an analogous art access system with hopping codes having sync values, nonlinear decoding and receiver with separate multibit secret keys 64 in fig. 2 and cols. 15-16.

It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to have included in US 6049289 the multibit secret keys at the transmitters and corresponding, but separate multibit secret keys at the receiver of Brewer'187 or Brewer'904 for secure access control.

6. Claims 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 of U.S. Patent No. 6049289 in view of Murray (US005347267A) or Lambropoulos (4881148).

Claims 1 and 4 of US6049289 include the limitations of claim 5 for the same reasons applied above to claim 1 except that US6049289 does not claim timeout from learn mode to the operating mode.

Murray discloses an analogous art code learning system with timeout form the learn mode in fig. 9 and col. 6 lines 10-21.

Lambropoulos discloses an analogous art code learning system with timeout form the learn mode in figs. 5A-C and col. 16-18.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in US 6049289 the timeout from the learn mode of Murray or Lambropoulos to prevent learning codes after a time expires to limit code storage and thus increasing security.

7. Claims 5 is rejected on the ground of nonstatutory

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obviousness-type double patenting as being unpatentable over claims 4 of U.S. Patent No. 6049289 in view of Heitschel '118 (US 475011).

Claims 1 and 4 of US6049289 include the limitations of claim 5 as applied above but does not expressly claim without user intervention. Heitschel'118 discloses an analogous art GDO receiver with random access memory (RAM) in CPU 44 for automatically and randomly storing transmitter codes without user intervention. See the last box on right side of fig. 3. See figs. 2-3 and col. 2 line 57 - col.4 line 57.

If without user intervention is not clear, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in US 6049289 the RAM of Heitschel'118 to automatically and randomly store transmitter codes without user intervention to prevent access to transmitters without stored codes and thus increasing security.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitschel '118 (US 475011) in combination with Bruwer'187 (US005517187A) or Brewer'904 (US 5686904).

Heitschel'118 discloses an analogous art GDO receiver with random access memory (RAM) in CPU 44 for automatically and randomly storing transmitter codes. Heitschel'118 compares received codes to a stored code, provides control if there is a match. If the codes do not match, Heitschel'118 repeats comparison with another stored code until there is match. Heitschel'118 does not disclose hopping codes with sync values and does not claim multibit secret keys at the transmitters and corresponding, but separate multibit secret keys at the receiver. See the last box on right side of fig. 3. See figs. 2-3 and col. 2 line 57 - col.4 line 57.

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Bruwer'187 discloses an analogous art access system with hopping codes having sync values, nonlinear decoding and receiver with separate multibit secret key 14 in fig. 2. See cols. 3-6.

Bruwer'904 discloses an analogous art access system with hopping codes having sync values, nonlinear decoding and receiver with separate multibit secret keys 64 in fig. 2 and cols. 15-16.

Regarding claims 1-2, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Heitschel'118 hopping codes having sync values, nonlinear decoding and secret keys of Bruwer'187 or Brewer '904 to prevent unauthorized control and increased security of a garage door operation. Regarding claim 3, it further would have been obvious to have included multibit secret keys at the transmitters and corresponding, but separate multibit secret keys at the receiver as disclosed in Bruwer'187 or Bruwer'904 for secure access control. Regarding claim 5, automatically and randomly storing said multibit secret keys without user intervention would have been obvious in view of automatically and randomly storing transmitter codes in the RAM of Heitschel'118 to prevent access to transmitters without stored codes and thus increasing security.

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11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heitschel '118 (US 475011) in combination with Bruwer'187 (US005517187A) or Brewer'904 (US 5686904) as applied above and further in view of Murray (US005347267A) or Lambropoulos (4881148).

Murray discloses an analogous art code learning system with timeout form the learn mode in fig. 9 and col. 6 lines 10-21.

Lambropoulos discloses an analogous art code learning system with timeout form the learn mode in figs. 5A-C and col. 16-18.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the timeout from the learn mode of Murray or Lambropoulos to prevent learning codes after a time expires to limit code storage and thus increasing security.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Issa (US 5798711) discloses a learning receiver with hopping codes.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 571-272-4100 or toll free at 1-866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600. Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308.

EH
1/5/07


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2612